

REMARKS

This paper responds to the *Office Action* mailed on June 24, 2009. No claims have been added and no claims are amended. Claims 73-112 were previously canceled and no claims are presently canceled. Therefore, claims 1-72 remain pending in this application.

Rejection of the Claims under 35 U.S.C. § 103(a)

On page 2, paragraph 3 of the *Office Action*, the Examiner rejected claims 1-3, 19-21, 37-39, and 55-57 under 35 U.S.C. § 103(a) as being obvious over U.S. Published Patent Application No. 2003/0046437 to Eytchison et al. (*Eytchison*) in view of U.S. Patent No. 6,112,246 to Horbal et al. (*Horbal*). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); *see also* MPEP § 2143). (Emphasis added).

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claimed elements. "If **any of these [three] findings** cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious."¹

¹ MPEP § 2143, emphasis added.

Independent claims 1, 19, 37, and 55

Independent claims 1, 19, 37, and 55 recite, in part, “[the] dissimilar communication devices ***communicate through a common interface that operates in said dissimilar communication devices*** in accordance with aspects of said dissimilar communication devices that have been abstracted.” (Emphasis added.) In the *Office Action* at page 3, the Examiner cites to col. 2 lines 20-30, col. 3 lines 26-50, col. 4 lines 30-35, and col. 5 lines 17-25 of *Horbal* and asserts that *Horbal* “discloses [a] micro-server that is implemented in networked devices and is used to abstract the functionality of the device and provide a common interface via Hyper Text Transfer Protocol (HTTP).” Applicants respectfully traverse the Examiner’s characterization of *Horbal* in this regard because the portions of *Horbal* relied upon by the Examiner do not disclose the above recitation of independent claims 1, 19, 37, and 55.

Specifically, *Horbal* discloses a micro-server embedded into a first device so that the first device can communicate to a second device. (See *Horbal* col. 1, lines 8-15). In effect, the micro-server operates in the first device, but does not operate in the second device.² Since *Horbal* merely discloses implementing the micro-server in only one of the two dissimilar communicating devices, *Horbal* cannot reasonably be considered to disclose “the dissimilar communication devices communicate through a common interface that operates in said dissimilar communication ***devices***” (note plurality of devices) as recited in independent claims 1, 19, 37, and 55. Furthermore, additional arguments for the non-obviousness of independent claims 1, 19, 37, and 55 are presented below under the *Response to Arguments* section.

For the reasons set forth above, Applicants submit that independent claims 1, 19, 37, and 55 are patentable under 35 U.S.C. § 103(a) over *Eytchison* in view of *Horbal*.

Response to Arguments

² See, for example, *Horbal*, Fig. 3 and col. 3, lines 26- 41, where a “remote thermostat device 300, equipped with a micro-server 302 . . . [is] connected to the same Ethernet network 304 as a client workstation 306.” Element 306, the client workstation, does not contain a micro-server. (*Id.* at Fig. 3.)

On page 12 of the *Office Action*, the Examiner asserts that *Horbal* does not teach away from *Eytchison* because,

Eytchison teaches against retrofitting existing services to accomplish tasks that they were never intended to perform. *Horbal*'s micro-server was created to abstract the functionality of a device (see figure 3). Therefore, *Horbal*'s micro-server is not performing tasks it was not intended to perform.

The problem with Eytchison's architecture is that there are single points of failure with respect to the proxy devices 201-206 (see figure 2). The person of ordinary skill in the art would turn to *Horbal* because *Horbal*'s architecture solves the problem of having a single point of failure (see col. 1 lines 43-45).

Applying *Horbal*'s embedded server does not obviate the need for transmitting data between dissimilar communication devices. All devices share a common micro-server interface but maintain their respective OEM code (see figure 4 of *Horbal*).

Applicants respectfully traverse the Examiner's characterization of *Horbal* and *Eytchison* in this regard because *Eytchison* and *Horbal* are not even properly combinable as obviousness references since *Horbal* teaches away *Eytchison*.

Eytchison discloses a "**protocol independent architecture** [that] permits the construction and use of portable applications and services for use in a **heterogeneous network**" (*Eytchison* at paragraph [0010]). *Eytchison* continues by disclosing that,

Each of the devices 101-105 communicates across the network using its own native communication protocols. Such protocols include, but not limited to, HAVi, UPnP, AV/C, IEA 851, OSGI, and XML. The devices 101-105 communicate with an abstraction layer (shown here comprising the DAL 210 and a content abstraction program interface 220). In this embodiment, the devices 101-105 ***communicate with the DAL using their own native communication protocols*** via proxies which are represented by blocks 201-206. (*Eytchison* paragraph [0033], emphasis added.)

Thus, *Eytchison* is concerned with allowing devices to communicate with different communication protocols such that the network architecture is *protocol independent*.

In contrast, *Horbal* discusses forcing all devices to communicate over the network on a single standardized communication protocol.

A micro-server interfaces with the first device to access information from the first device. *The information is then organized and formatted compatible with a communication protocol in preparation for making the information available to said second device*. The information is made available to the second device while abstracting the communication protocol from the first device.

The system could include: . . . an *HTTP protocol* server for satisfying interactive HTTP requests. (*Horbal* at col. 2 lines 21-38, emphasis added.)

Because *Horbal* forces all devices to communicate on a single standardized communication protocol (e.g., HTTP), it is protocol dependent. Thus, *Horbal* entirely ignores the issue of allowing a protocol independent network architecture by forcing all devices to communicate through a single protocol such as HTTP³.

Consequently, *a person of ordinary skill in the art concerned with the problem of a plurality of dissimilar communication devices in a protocol independent network architecture, as found in Eytchison, would not look to Horbal to remedy the problem*. *Horbal* discusses embedding a micro-server into each device and then implementing the same communications protocol for each device for communication across the network. In contrast, *Eytchison* is concerned with retaining a protocol independent architecture for the network such that devices can communicate in a variety of communications protocols.

³ See, for example, “FIG 4 is a simplified block diagram showing possible components of a micro-server.” (*Horbal* at col. 8, lines 20-21.) Element 422 on the micro-server is an “HTTP Protocol Server.” (*Id.* At Fig. 4)

Furthermore, as discussed in the Response of March 20, 2009, *Eytchison* discusses that that problems exist where devices are unable to communicate with other devices on existing infrastructures where the devices are not based on the same protocol.

Typical protocols are defined by standards . . . Such protocols will collectively be referred to as communications protocols or just protocols.

Such communications protocols are used to provide device-centric standards which solve many problems relating to device control and interoperability. Thus, *as long as the devices comply with the standards, they can communicate with other networked devices which comply with the same standard*. Although satisfactory for these limited, but necessary purposes, *they fall short as effective content management tools on existing infrastructures*. (*Eytchison* at paragraphs [0004] to [0005]. Emphasis added.)

Thus, *Eytchison* is also concerned with *existing devices* that are not standardized on a given protocol. However, as discussed above, *Horbal* is not concerned with having devices based on non-standard protocols (i.e., the various device native communication protocols of *Eytchison*).

Consequently, a person of ordinary skill in the art concerned with the problem of a plurality of devices based on non-standard protocols in an existing infrastructure, as found in *Eytchison*, would not look to *Horbal* to remedy the problem. *Horbal* discusses embedding a new micro-server into each device and then implementing the same communications standard into each device. *Eytchison* is concerned with communications in an existing infrastructure (especially with reference to existing consumer electronics⁴) *to avoid retrofitting every device* with an embedded micro-server.

Thus, the references of *Horbal* and *Eytchison* are not combinable because *Horbal* teaches away from the very problem *Eytchison* is trying to solve.

⁴ See, for example, *Eytchison* at paragraph [0033].

The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. (*Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990).) When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. (*Id.* at 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966).)

Since the references are not properly combinable, asserting that the cited references teach the Applicants' claimed elements is merely conclusory with no actual support found in either *Horbal* or *Eytchison*. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007)). Although the Examiner cites to portions of the cited references, there is no rational argument providing a legal nexus between the cited portions and Applicants' claims. Moreover, since the references are not properly combinable, then they cannot teach or suggest, in combination, all limitations of Applicants' claims.

Since the references are not properly combinable and not all elements are taught or suggested by the cited art, Applicants respectfully request the Examiner to reconsider and remove the rejection under 35 U.S.C. § 103(a) with regard to Applicants' independent claims 1, 19, 37, and 55. Further, since claims 2-3, 20-21, 38-39, and 56-57 depend, either directly or indirectly, from independent claims 1, 19, 37, and 55, respectively, they too are allowable for at least the same reasons. Further, these dependent claims each may contain additional patentable subject matter.

On page 4, paragraph 8 of the *Office Action*, the Examiner rejected claims 1-5, 8, 17-18, 19-23, 26, 35-36, 37-41, 44, 53-54, 55-59, 62, and 71-72 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,853,637 to Norrell et al. (*Norrell*), in view of *Eytchison* and *Horbal*. However, as shown above, *Eytchison* is not properly combinable with *Horbal*. *Norrell*

does nothing to cure the deficiencies found in either *Eytchison* or *Horbal*. Thus, claims 1-5, 8, 17-18, 19-23, 26, 35-36, 37-41, 44, 53-54, 55-59, 62, and 71-72 are all allowable for at least the same reasons as given above.

On page 7, paragraph 19 of the *Office Action*, the Examiner rejected claims 6-7, 24-25, 42-43, and 60-61 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison* and *Horbal*, as applied to claims 5, 23, 41, and 59 above, and further in view of U.S. Patent No. 7,191,236 to Simpson-Young et al. (*Simpson-Young*). On page 8, paragraph 23, the Examiner rejected claims 9-10, 27-28, 45-46, and 63-64 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison* and *Horbal* et al., as applied to claims 4, 22, 40, and 58 respectively above, and further in view of U.S. Published Patent Application No. 2002/0099867 to Wilkinson et al. (*Wilkinson*). On page 9, paragraph 26 the Examiner rejected claims 11-13, 29-31, 47-49, and 65-67 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison* and *Horbal*, as applied to claims 1, 19, 37, and 55 above, and further in view of U.S. Patent No. 6,789,123 to Li et al. (*Li*). On page 10, paragraph 29 of the *Office Action*, the Examiner rejected claims 14, 32, 50, and 68 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison* and *Horbal*, as applied to claims 1, 19, 37, and 55 above, and further in view of U.S. Published Patent Application No. 2001/0030950 to Chen et al. (*Chen*). On page 10, paragraph 31, the Examiner rejected claims 15, 33, 51, and 69 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison*, *Horbal*, and *Chen*, as applied to claims 14, 32, 50, and 68 above, and further in view of U.S. Patent No. 6,298,069 to Prabhu et al. (*Prabhu*) and U.S. Patent No. 6,233,611 to Ludtke et al. (*Ludtke*). Finally, on page 11, paragraph 33 of the *Office Action*, the Examiner rejected claims 16, 34, 52, and 70 under 35 U.S.C. § 103(a) as being obvious over *Norrell* in view of *Eytchison* and *Horbal*, as applied to claims 1, 19, 37, and 55 respectively above, and further in view of *Ludtke*.

However, each of these claims depend either directly or indirectly from one of the independent claims, 1, 19, 37, or 55, that Applicants have shown to be allowable. Neither

Simpson-Young, Wilkinson, Li, Chen, Prabhu, nor Ludke do anything to cure the deficiencies of either *Eytchison* or *Horbal*, above. Thus, each of these dependent claims is allowable for at least the same reasons as given above with regard to independent claims 1, 19, 37, and 55.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(408) 660-2015

Date August 17, 2009

By 
Bradley W. Scheer
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 17, 2009.


Jonathan Ferguson